

REMARKS

Claims 1-14, 16-26, 28, and 29 are pending. Claims 1, 8, 14, 17, 20, and 23 are independent.

In the Office Action, claims 1-14, 16-26, 28, and 29 were rejected under 35 U.S.C. § 101 as being directed to purportedly non-statutory subject matter due to an alleged lack of subject matter to “produce a real life, real world, useful, concrete, and tangible result.” Office Action at 2.

Applicants respectfully disagree with the claim rejection because it is completely contrary to current legal precedent. According to the Federal Circuit, the inquiry of whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1375 (Fed. Cir. 1998). If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. See State Street, 149 F.3d at 1373; AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1358 (Fed. Cir. 1999). And if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101.

The Office Action refers to the Patent Office’s Interim Guidelines for Examination of Patent Applications for Statutory Subject Matter Eligibility (“the Guidelines”). Quoting In re Oetiker, 997 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), the Guidelines note, in section IV(D), that “[t]he examiner bears the initial burden . . . of presenting a prima facie case of unpatentability.” The Guidelines further note, in section IV(B), that “if the examiner determines that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, the examiner must provide an

explanation.” However, the Office Action provides no such explanation or analysis attempting to explain the Examiner’s conclusion that the pending claims are purportedly directed to non-statutory subject matter. For at least this reason, the Office Action has failed to establish a prima facie case of unpatentability.

Applicants also disagree with the section 101 rejection for several additional reasons. In particular, each of independent claims 1, 8, 14, 17, 20, and 23 is drawn to subject matter clearly falling within one or more of the statutory categories of patentable subject matter. 35 U.S.C. § 101 specifies that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor” Claims 1, 14, and 20 are drawn to methods, i.e., “process[es],” as set forth in 35 U.S.C. § 101, and claims 8, 17, and 23 are each drawn to a system, i.e., a “machine,” as set forth in 35 U.S.C. § 101. Apparatus claims 8, 17, and 23 recite structural elements including, for example, an input device and an analyzer. In addition, method claims 1 and 14 include structural recitations such as, for example, a data system. In addition, each of claims 1, 8, 14, 17, 20, and 23 includes recitations relating to “machine data representing at least one condition of a machine.” Therefore, independent claims 1, 8, 14, 17, 20, and 23 each set forth machines and/or processes within the scope of 35 U.S.C. § 101. Thus, it is clear that each of the pending claims falls within one or more of the statutory categories of patentable subject matter.

Further, each of independent claims 1, 8, 14, 17, 20, and 23 defines an invention that, as a whole, produces a “useful, concrete, and tangible result,” as required by State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1373 (Fed.

Cir. 1998.). As noted in the Guidelines, at section IV(C)(2)(b)(1), “for an invention to be ‘useful’ it must satisfy the utility requirement of section 101.” Citing MPEP § 2107 and quoting In re Fisher, 421 F.3d 1365, (Fed. Cir. 2005); 76 U.S.P.Q.2d (BNA) 1225, 1230, the Guidelines further note that “[t]he USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible.”

Independent claims 1, 8, 14, 17, 20, and 23 set forth systems and methods for analyzing machine data, involving determination of a machine exception via data acquired through one or more diagnostic processes. Each of independent claims 1, 14, and 20 recites generating a notification or report in the event of a machine exception. Each of independent claims 8, 17, and 23 recites an analyzer configured to generate a notification or report in the event of a machine exception. Notification or reporting in the event of a machine exception has significant practical utility. For instance, when notified of such machine exceptions, interested persons may use the reported information to assess operating conditions of a machine for various purposes. For example, as disclosed in the specification in paragraph [02], operating conditions may be monitored for service and diagnostic purposes and/or to evaluate machine and/or operator performance. As the specification further notes in paragraph [04], it is “important to predict failures so servicing can be scheduled during periods in which productivity will be less affected and so minor problems can be repaired before they lead to catastrophic failures, and it is important to monitor machine and operator performance to increase

productivity.”¹ Notifying and reporting in the event of machine exceptions associated with acquired data regarding machine operating conditions produces a concrete, tangible, and useful result. For at least this reason, each of independent claims 1, 8, 14, 17, 20, and 23 produce a result which is “useful,” as required by State Street.

According to section IV(C)(2)(b)(3) of the Guidelines, which cites In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000), in order to produce a concrete result, a “process must have a result that can be substantially repeatable or the process must substantially produce the same result again.” The pending claims set forth systems and methods for processing or checking machine data to determine machine exceptions and further generating a report/notification relating to such machine exceptions. That is, each time a piece of data falls outside of a predetermined range, it may be identified and reported as a machine exception. There is no ambiguity as to the repeatability of such automated data analysis. Therefore, the pending claims produce a concrete result as required by State Street.

According to section IV(C)(2)(b)(2) of the Guidelines, in order to produce a tangible result, a process must produce a result that is not “abstract.” The generation of a machine exception report or notification, as set forth in claims 1, 8, 14, 17, 20, and 23, is not abstract, since information provided by such a report/notification is useful to parties interested in service and/or performance of a machine, as discussed above. Because independent claims 1, 8, 14, 17, 20, and 23 recite subject matter that produce

¹ These and other features, mentioned herein, of the disclosed systems and methods are provided as examples only and are not intended to be limiting as to the utility of the disclosed systems and methods.

useful, concrete, and tangible results, the section 101 rejection of claims 1-14, 16-26, 28, and 29 should be withdrawn.

Applicants respectfully request the withdrawal of the Section 101 rejection and the timely allowance of the pending claims.

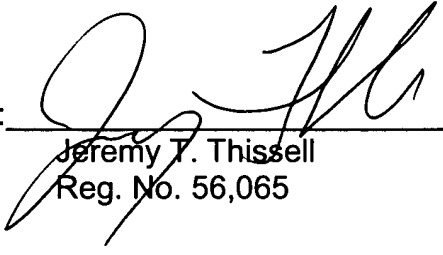
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: _____


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